



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,167	10/22/2003	Youssef L. Bennani	6995.US.O2	6527
23492	7590	12/23/2005		
ROBERT DEBERARDINE ABBOTT LABORATORIES 100 ABBOTT PARK ROAD DEPT. 377/AP6A ABBOTT PARK, IL 60064-6008			EXAMINER LEWIS, AMY A	
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,167

Applicant(s)

BENNANI ET AL.

Examiner

Amy A. Lewis

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-62 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 50-61, drawn to a compound of Formula II, classified in class 514, subclass 507.
- II. Claims 1-45, drawn to a method of treating migraine, epilepsy, or bipolar disorder with a compound of Formula I, classified in class 514, subclass 507.
- III. Claims 46-47, drawn to a method of treating a psychiatric disorder, pain, or a movement disorder with a compound of Formula I, classified in class 514, subclass 507.
- IV. Claims 48-49, drawn to a method of providing neuroprotection with a compound of Formula I, classified in class 514, subclass 507.
- V. Claim 62, drawn to a method treating neuropathic and inflammatory pain with a compound of Formula I, classified in class 514, subclass 507.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II, I and III, I and IV, and I and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case

Art Unit: 1614

the compound of Formula II (which is a species of claimed Formula I) can be used in a variety of treatment methods, such as treating migraine (of Invention II), movement disorders (of Invention III), inflammatory pain (of Invention IV), or in a method of providing neuroprotection (of Invention V). In addition, the disorders of Inventions II-V can be treated with other products, for example epilepsy (of Invention II) can be treated with diazepam, or inflammatory pain can be treated with a non-steroidal anti-inflammatory drug (NSAID).

Inventions II through V are, each from the other, independent and distinct inventions. The disorders of Inventions II through V are different disorders with different, etiologies, pathologies, symptoms, and patient populations; treatment of one disorder would not be expected to result in the treatment of the disorders of the other inventions.

Election of Species

Applicant is required under 35 U.S.C. 121 to elect one of Inventions I-V and in addition, a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

A. Applicant should elect ***one specific compound*** for the practice of the invention, which falls within the criteria of Formula I and wherein ***every*** variable is identified, for example the compound 2,3-dimethylcyclohexanecarboxamide of the Markush group of claim 5.

Art Unit: 1614

B. The practice of Inventions II-V defined above involves the treatment of a variety of disorders. Applicant should elect disorder as follows:

- Should Applicant elect Invention II, Applicant should also elect one of a) migraine, b) epilepsy, or c) bipolar disorder.
- Should Applicant elect Invention III, Applicant should also elect one of d) psychiatric disorder, e) pain, or f) a movement disorder.
- Should Applicant elect Invention V, Applicant should also elect one of g) neuropathic or h) inflammatory pain.

The election in items A and B will be given effect in the event that the Markush-type claims are not found allowable at which time the examination of the claims presented will be limited to the Markush-type claims and claims directed solely to the election made as to item A and B. The claims directed to nonelected items will be held withdrawn from further consideration. The election is a requirement for restriction. *In re Herrick*, 1858 CD 1, and *In re Joyce*, 19558 CD 2.

Applicant's response must include a provisional election of one of A and B and must include an identification of the invention that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Art Unit: 1614

Upon the allowance of a claim generic with regard to item C above, applicant will be entitled to consideration of claims to additional species of item C above which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 C.F.R. 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86(March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Art Unit: 1614

Contact Information:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy A. Lewis whose telephone number is (571) 272-2765. The examiner can normally be reached on Monday-Friday, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Amy A. Lewis
Patent Examiner
Art Unit 1614



Christopher Low
SPE
Art Unit 1614



CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800